

REMARKS

The application has been amended to correct the cited informalities and to place the application as a whole into a *prima facie* condition for allowance at this time. Care has been taken to avoid the introduction of any new subject matter into the application as a result of the foregoing amendments.

The Examiner has rejected claims 2-4 under 35 U.S.C. §112, second paragraph, as purportedly being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicant regards as the invention. The Examiner has also made the following rejections based on the cited prior art: (1) claims 1-2 and 5-8 under 35 U.S.C. 102(b) as purportedly being anticipated by Brennan et al., U.S. Pat. No. 5,906,369; (2) claims 3-4 under 35 U.S.C. §103(a) as purportedly being unpatentable over Brennan et al., in view of Jessop, U.S. Pat. No. 6,171,168; (3) claims 9-10 under 35 U.S.C. §103(a) as purportedly being unpatentable over Brennan et al., in view of Lipsitz et al., U.S. Pat. No. 4,438,191, further in view of Chuang, U.S. Pat. No. 6,022,025; (4) claim 11 under 35 U.S.C. §103(a) as purportedly being unpatentable over Brennan et al., in view of Lipsitz et al., further in view of Chuang and Jessop; and (5) claims 13-14 under 35 U.S.C. §103(a) as purportedly being unpatentable over Brennan et al., in view of Shackelford, U.S. Pat. No. 6,227,931. Applicant respectfully traverses each of these bases for rejection.

The Examiner has rejected claims 2-4 under 35 U.S.C. §112, second paragraph, as purportedly being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicant regards as the invention. Specifically, the Examiner has stated that the antecedent basis for the term "the user" found in those claims has not

been clearly set forth. In response thereto, Applicant has amended each of claims 2-4 to delete the language which the Examiner has contended is objectionable. Applicant respectfully submits that these changes do not affect the scope of the claims in any way. Furthermore, Applicant has also amended claims 10, 11, 12 and 14 to likewise delete any reference to "the user". Accordingly, reconsideration and withdrawal of the rejection of claims 2-4 under 35 U.S.C. §112, second paragraph, is respectfully solicited.

With regard to the Examiner's rejection of claims 1-2 and 5-8 as purportedly being anticipated by Brennan et al., Applicant respectfully submits that this reference should be deemed incapable of teaching or suggesting the patentably distinct structure of Applicant's invention of claims 1-2 and 5-8, and that said claims should be deemed patentable thereover.

The Brennan et al. reference discloses an electronic matching game apparatus including a plurality of game pieces, together with a base assembly having receptacles for interchangeably receiving said game pieces. Each of the receptacles includes a plurality of switches coupled to a sound generating device for producing a plurality of sounds, each sound being associated with one of the game pieces. Each of the game pieces includes selectively located projections 72A-D for selectively engaging selected switches which correspond to the respective sound for each game piece. Notably, however, Brennan et al. neither teaches nor suggests objects (game pieces) including electrical contact elements connected to one another to form a contact pattern which serves to uniquely identify the associated game piece. To the contrary, Brennan et al. teaches merely that the non-conductive projections 72A-72D (located on the game

pieces) engage with push pads 68 (located within the receptacle), which in turn press conductive pads 70 (located within the receptacle) into engagement with switches 62 located therebelow, thus closing switches 62 (Col. 5, lines 61-67).

Applicant respectfully submits that claims 1-2 and 5-8 of the present invention patentably distinguish over the Brennan et al. reference. Applicant's claim 1 requires both (a) a plurality of objects, each of which includes a plurality of object contact elements, wherein two or more of such contact elements are connected to one another to form a contact pattern serving to uniquely identify the associated object, and (b) an identification member including a plurality of member contact elements configured such that at least two of the member contact elements come into electrical contact with at least two of the object contact elements. Neither of elements (a) or (b) are taught or suggested by Brennan et al. Indeed, there can be no question but that projections 72A-D of Brennan et al. are not "connected to one another to form a contact pattern", as there is no teaching or suggestion that these projections are connected in any way, shape or form—much less being in electrical contact with one another. To the contrary, Applicant's object contact elements are disposed in direct electrical contact with one another, so as to permit a circuit to be formed when the object contact elements are brought into electrical contact with the member contact elements.

Furthermore, Brennan et al. neither teaches nor suggests that any of projections 72A-D ever come into electrical contact with either conductive pads 70 or switches 62, as is also required by Applicant's claim 1. To the contrary, it can be clearly seen from Fig. 23 of Brennan et al. that projections 72A-D cannot come into direct contact (electrical or otherwise) with conductive pads 70 or switches 62, due to the fact that

push pads 68 are positioned therebetween. Moreover, even if projections 72A-D were able to directly contact conductive pads 70 or switches 62, no current would flow through projections 72A-D in any event—as Brennan et al. neither teaches nor suggests the presence of any conductive linkage between any of projections 72A-D. Accordingly, there is simply no teaching or suggestion in Brennan et al. of “electrical contact” between projections 72A-D and conductive pads 70 or switches 62—as a result of which that reference is incapable of anticipating Applicant’s claim 1. Accordingly, reconsideration and withdrawal of the rejection of claim 1, based on the Brennan et al. reference, is respectfully solicited.

Inasmuch as dependent claims 2 and 5-8 merely serve to further define the subject matter of claim 1, which itself should be deemed allowable, reconsideration and withdrawal of the rejection of those claims, and allowance thereof, are respectfully requested.

The Examiner has made the following rejections under 35 U.S.C. §103(a): (1) claims 3-4 as purportedly being unpatentable over Brennan et al. in view of Jessop; (2) claims 9-10 as purportedly being unpatentable over Brennan et al. in view of Lipsitz et al., still further in view of Chuang; (3) claim 11 as purportedly being unpatentable over Brennan et al. in view of Lipsitz et al., still further in view of Chuang and Jessop; and (4) claims 13-14 as purportedly being unpatentable over Brennan et al. in view of Shackelford. Applicant respectfully traverses each of these bases for rejection. Specifically, Applicant respectfully traverses the Examiner’s alternative combinations of the respective cited references.

Two or more references may not be combined to support an assertion of obviousness of a claimed invention, absent some teaching or suggestion to their combination. Further, two or more references may not properly be combined if to do so would serve to frustrate the functions, goals or purposes of one or both of the respective references.

First, Applicant respectfully traverses the Examiner's assertion that claims 3-4 are unpatentable over Brennan et al. in view of Jessop, based on the Examiner's contention that Brennan et al. discloses all of the claimed subject matter, with the exception of computer-generated human speech and/or movement of a portion of the apparatus in response to identifying objects that are in physical contact with the identification member. As discussed above, Brennan et al. does not disclose all of the claimed subject matter of claim 1, inasmuch as that reference neither teaches nor suggests either (a) a plurality of object contact elements which are connected to one another to form a contact pattern, or (b) at least two identification member contact elements coming into electrical contact with at least two object contact elements.

Moreover, even if Brennan et al. did in fact disclose the subject matter of claim 1, its combination with Jessop would be inappropriate in the complete absence of any teaching in either of the references to such a combination. Indeed, their combination would only serve to frustrate their respective goals and purposes. Combining the cited references in an attempt to reconstruct Applicant's invention, with benefit of the hindsight afforded by Applicant's own disclosure, deviates from the teachings of each of these cited references.

Specifically, Jessop teaches a completely different method of object recognition than that taught by Brennan et al.—namely, the use of an object sensor means for sensing an identity code associated with each of the objects, together with a movement detection means for sensing a movement code associated with movements of the objects. Combination of the two references would in fact frustrate the purposes of both, by combining two different methods of object recognition, which may not be appropriate or useful for the particular objects of interest, into a single device. Accordingly, reconsideration and withdrawal of the rejection of claims 3-4, based on the Brennan et al. reference, is respectfully solicited.

Second, Applicant respectfully traverses the Examiner's assertion that claims 9-10 are unpatentable over Brennan et al. in view of Lipsitz et al., still further in view of Chuang, based on the Examiner's contention that Brennan et al. discloses all of the claimed subject matter excluding the incorporation of the identification member into a fishing pole and hook. As discussed above, Brennan et al. does not disclose all of the claimed subject matter of claim 1, inasmuch as that reference neither teaches nor suggests either (a) a plurality of object contact elements which are connected to one another to form a contact pattern, or (b) at least two identification member contact elements coming into electrical contact with at least two object contact elements.

Moreover, even if Brennan et al. did in fact disclose the subject matter of claim 1, its combination with Chuang would be inappropriate in the complete absence of any teaching in either of the references to such a combination. Indeed, their combination would only serve to frustrate their respective goals and purposes. Combining the cited references in an attempt to reconstruct Applicant's invention, with benefit of the

hindsight afforded by Applicant's own disclosure, deviates from the teachings of each of these cited references.

Specifically, Chuang teaches a fishing toy comprising a fishing rod and a toy fish, in which all of the electronics are contained within the object (the toy fish)—not within the identification member (the rod). The rod simply comprises a mechanical device for “catching” the object. To the contrary, Brennan et al. teaches a game apparatus in which all of the electronics are contained within the identification member (the base assembly)—not within the objects (the farm animals). Combination of the two references would in fact frustrate the functions and purposes of both, by combining either an electronics-containing identification member with an electronics-containing object, or a non-electronics containing identification member with a non-electronics-containing object. In either case, the resultant combination would not function according to the teachings of either reference. Accordingly, reconsideration and withdrawal of the rejection of claims 9-10, based on the Examiner's combination of the Brennan et al., Chuang, and Lipsitz et al. references, is respectfully solicited.

Third, Applicant respectfully traverses the Examiner's assertion that claim 11 is unpatentable over Brennan et al. in view of Lipsitz et al., still further in view of Chuang and Jessop, based on the Examiner's contention that Brennan et al., Lipsitz et al., and Chuang disclose all of the claimed subject matter excluding the use of computer-generated human speech in response to identifying objects that are in physical contact with the identification member. As discussed above, Brennan et al., Lipsitz et al., and Chuang do not disclose all of the claimed subject matter of claim 10, from which claim 11 depends. Moreover, even if Brennan et al. did in fact disclose the subject matter of

claim 1, its combination with Chuang and/or Jessop would be inappropriate in the complete absence of any teaching in either of the references to such a combination—as discussed above. Accordingly, reconsideration and withdrawal of the rejection of claim 11 is respectfully solicited.

Fourth, Applicant respectfully traverses the Examiner's assertion that claim 11 is unpatentable over Brennan et al. in view of Shackelford, based on the Examiner's contention that it would have been obvious to a person of ordinary skill in the art to modify the contact elements disclosed by Brennan et al., by prescribing conductive contact elements for the object, in light of the teachings of Shackelford. Applicant respectfully submits that a combination of those references would be inappropriate in the complete absence of any teaching in either of the references to such a combination. Indeed, their combination would only serve to frustrate their respective goals and purposes. Combining the cited references in an attempt to reconstruct Applicant's invention, with benefit of the hindsight afforded by Applicant's own disclosure, deviates from the teachings of each of these cited references.

Specifically, Shackelford teaches a child's electronic playset defining a setting or character environment for various toy characters 57-60, each of which is provided with an identical set of electrical contacts (best seen in Figs. 7A and 7C), to enable each of the characters to be interchangeably inserted onto various sensors 70 located throughout the playset (Col. 7, lines 60-65). Each of characters 57-60 further includes an electrical resistor 65, which permits a computerized controller 90 to identify a character by measuring the current which is transmitted through resistor 65 when the character is placed onto a sensor 70. The individual characters can thusly be

differentiated from one another based on the magnitude of the current, or other electrical characteristics, detected by the controller (Col. 7, lines 26-59). Thus, the invention disclosed by Shackelford requires that the "contact elements" (foot side contacts 68 and 69) in each distinct object have an identical configuration, so as to permit each of those objects to be interchangeably positioned at any of the various sensors throughout the environment. Identification of the objects (characters) does not depend in any way on the configuration of the object contact elements—as that configuration is identical for all objects. In Brennan et al., however, identification of the objects (farm animals 18-28) depends entirely on the configuration of the object contact elements—as it is precisely that configuration which determines the pattern of switches in the identification member (base assembly 46) that are triggered by placing the object into the respective receptacle thereon.

Moreover, even if the contact elements of Brennan et al. were modified as suggested by the Examiner—by prescribing conductive contact elements for the object—the resultant combination still would not disclose the method of Applicant's claim 13. This is due to the fact that the contact elements of Brennan et al. (projections 72A-D) cannot come into direct contact with conductive pads 70 or switches 62, due to the fact that push pads 68 are positioned therebetween. Accordingly, no electrical current would pass from the identification member (base assembly 46) to the object (farm animals 18-28), as required by Applicant's claim 13. Moreover, even if projections 72A-D were able to directly contact conductive pads 70 or switches 62, no current would result, due to the fact that the projections are not connected with one another so

as to form a unique contact pattern. Accordingly, reconsideration and withdrawal of the rejection of claims 13-14 is respectfully solicited.

Finally, Applicant notes that the Examiner has not specifically recited a basis for rejection of claim 12. Accordingly, Applicant has not addressed claim 12 in the remarks set forth hereinabove. Should the Examiner continue to maintain a basis for rejection of claim 12 after considering Applicant's remarks, Applicant respectfully requests that the Examiner set forth his basis for rejection of that claim in detail in a subsequent Office Action.

In view of the foregoing, Applicant respectfully submits that the Examiner's bases for rejection of claims 1-14 should be deemed overcome. Accordingly, reconsideration and withdrawal of the aforementioned bases for rejection, and allowance of claims 1-14, are respectfully solicited.

Should anything further be required, a telephone call to the undersigned, at (312) 456-8400, is respectfully invited.

Respectfully submitted,
GREENBERG TRAURIG, P.C.



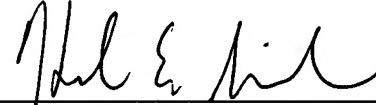
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Dated: July 17, 2003

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Dated: July 17, 2003


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